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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/596,697 | 06/21/2006 | Carlo Gelmetti | PRINZ S5026 | 9635 |
| 27667 | 7590 | 01/29/2008 | EXAMINER | |
| HAYES SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718 | | | GEHMAN, BRYON P | |
| ART UNIT | | PAPER NUMBER | | |
| 3728 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/596,697 | GELMETTI, CARLO |
| | Examiner | Art Unit |
| | Bryon P. Gehman | 3728 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 06 March 2007.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 24-46 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 24-46 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 24-46 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 21 June 2006 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/26/06+8/14/06.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .
5) Notice of Informal Patent Application
6) Other: ____ .

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

The phrase "material to examination" is deficient, and the entire clause 37 CFR 1.56 must be identified, not a portion thereof.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph **on a separate sheet** within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it is not by itself on a separate sheet, and includes legal phraseology, i.e., "spacing means" in line 2. Correction is required. See MPEP § 608.01(b).

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the arrangement of structure where the spacer defines the slot in the cover and also comprises an adhesive strip or inner and outer labels, or a narrow portion of the slot, or the slot extending from an edge of the cover must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 24 and 29-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 24, the spacer is set forth as it "defines an inner portion and an outer portion of the slot". In claims 29-33, the spacer is further defined as being formed from an adhesive strip or label. It is not seen in the drawings nor explained sufficiently in the specification how the adhesive strip or labels define the slot as claimed. It is not seen in the drawings nor explained sufficiently in the specification how the spacer defines an inner portion and an outer portion of the slot and a plate attached to an upper surface of the cover. Accordingly, the subject matter as set forth in claims 29-38, in conjunction with parent claim 24, are indefinite as the arrangement of structure is seen to be defined or is unclear in its description by way of the drawings to support the subject matter as claimed.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 24-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 24, line 2, "the welding wire" lacks antecedent basis, as no welding wire per se is necessarily distinguished by a welding wire container per se.

In claim 25, the purely functional recitation of "its spacing effect can be overcome by the welding wire" is vague and indefinite as to what structure such is meant to distinguish.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Dragoo et al. (7,152,735). Claims 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Moore (6,715,608). Claims 24-27 and 39-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitt et al. (4,451,014).). Claims 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Frederick et al. (3,823,894).

Claims 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Jenson (3,096,951). Each discloses a cover (50; 50; 16; 44; 16; respectively) for a welding wire container having an upper surface provided with a slot (61; at 60; 74; receiving 30; receiving 42) through which welding wire may be withdrawn from the container, and a spacer (76-82; 62; 66; 30; 42) defining an inner portion (at 80; 62 inside 52; at base of 60; lower end of 30; lower end of 42) and an outer portion (at 76; 62 outside 52; at top of 60; outer end of 30; 44) so that welding wire extending through the inner portion of the slot is held spaced from welding wire extending through the outer portion of the slot. of the slot.

As to claim 25, while the wire portions to be dispensed will be spaced, such does not preclude the wire portions being relatively adjacent.

As to claim 26, each discloses the spacer to be detachable from the cover.

As to claim 27, each discloses the spacer being of a construction inherently destructible by human force.

As to claims 39 and 40, Kitt et al. disclose an elevated portion (at 60) as a truncated cone.

As to claims 44-46, each further discloses welding wire container having a body (18; 10; 12; 11; 10).

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Moore, Kitt et al. and Frederick in view of Priest (4,274,607). None of Moore, Kitt et al. and Frederick discloses the spacer thereof being deflectable as claimed. However, Priest discloses a spacer (32) formed so as to be deflectable (at 58a) to allow wire to pass the spacer in the deflected condition. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the cover of any one of Moore, Kitt et al. and Frederick with the spacer of Priest as claimed, as such a modification would predictably serve to guide and restrain wire being dispensed through the cover in the manner suggested by Priest in conjunction with wire coil containers. "A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1731, 82 USPQ2d at 1396.

13. Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitt et al. To modify the elevated portion of Kitt et al. to comprise a truncated pyramid shape as claimed would entail a mere change in shape of the raised portion and yield only predictable results. "[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual

application is beyond that person's skill." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1740, 82 USPQ2d 1396 (2007). A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

14. Claims 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art employed against claim 24 above. Each reference discloses a slot of unspecified dimension. It would have been an obvious matter of design choice to provide a slot of desired size, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

15. This application contains claims directed to the following patentably distinct species: I) Figures 1-4; II) Figure 5; III) Figure 6; IV) the unshown arrangement where the slot is defined by an adhesive strip; V) the unshown arrangement where the slot is defined by two labels; VI)) the unshown arrangement where the slot is defined by a narrow portion; and VII)) the unshown arrangement where the slot extends from an edge of the cover. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none of the claims appears generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that a reply to this requirement must include i) an identification of the species to be examined even though the requirement may be traversed (37 CFR 1.143) and ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are

added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Tuesday through Thursday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Bryon P. Gehman
Primary Examiner
Art Unit 3728

BPG